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**SEP 20 2005**

**OFFICE OF PETITIONS**

In re Application of  
Steven L. Vanfleet, John J. Mascavage,  
Matthew T. Byrne, Diane Wing, Cassandra J.  
Mollett, Suzanne Rogers, Blake Benton,  
Timothy Horton, Susan M. Nelson, Rhonda D.  
Sargent, Martin Stivers, and Gary J. Trainor  
Application No. 10/825,960  
Filed: April 16, 2004  
Attorney Docket Number: 020375-050200US  
Title: METHODS AND SYSTEMS FOR  
PRIVATE LABEL TRANSACTION  
PROCESSING

DECISION ON TWO PETITIONS  
UNDER 37 C.F.R. §§1.47(a) and 1.48(a)

This is in response to the two petitions under 37 C.F.R. §§1.47(a)<sup>1</sup> and 1.48(a)<sup>2</sup>, concurrently filed August 18, 2005.

<sup>1</sup> A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
  - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
  - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

<sup>2</sup> A grantable petition under 37 C.F.R. §1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;

The above-identified application was filed on April 16, 2004, identifying Steven L. Vanfleet, John J. Mascavage, Matthew T. Byrne, Diane Wing, and Cassandra J. Mollett as joint inventors. No oath or declaration was submitted on filing. On June 25, 2004, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that a fully executed oath or declaration and the associated surcharge were required, along with the basic filing fee, and additional claim fees. This Notice set a two-month period for reply.

On August 30, 2004 (the response contained a certificate of mailing dated August 25, 2004), Petitioner submitted the associated surcharge, the basic filing fee, additional claim fees, and an oath that was executed by each of the joint inventors.

The petition under 37 C.F.R. §1.47(a):

With the present petition, Petitioner has submitted the petition fee, the surcharge, additional claim fees, a statement of facts, and a declaration which has been executed by each of the joint inventors save Mr. Mascavage.

Petitioner has met requirements (1) - (3), and (5) above.

Regarding the fourth requirement above, Petitioner has not submitted adequate proof that diligent efforts have been made to either present the non-signing inventor with a complete copy of the application or locate the non-signing inventor. Petitioner sent the declaration to the inventor via e-mail and postal mail, but a complete copy of the application was not included. Furthermore, Petitioner learned that the non-signing inventor no longer resided at the last known address, yet it does not appear that any effort was made to locate the same.

Rule 47 applicant will need to attempt to verify the address of the non-signing inventor or determine her forwarding address and send a complete copy of the application papers to that address for consideration by the inventor<sup>3</sup>. If attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet fail, then applicant will have provided the necessary proof required under 37 C.F.R. §1.47 that the inventor cannot be reached. Alternatively, Petitioner could send a complete copy of the application to the e-mail address of the non-signing inventor.

Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicant should

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- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
  - (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
  - (4) The processing fee set forth in § 1.17(i); and
  - (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

<sup>3</sup> See MPEP 409.03(d).

submit documentary evidence such as the results of an E-mail or Internet search. It is important that the statement contain facts as opposed to conclusions<sup>4</sup>.

As such, the petition under 37 C.F.R. §1.47(a) must be **DISMISSED**.

The petition under 37 C.F.R. §1.48(a):

With the present petition, Petitioner has submitted a request to correct the inventorship that sets forth the desired inventorship change, a statement from each person being added as an inventor, an oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.475, the petition fee, and the written consent of the assignee pursuant to 37 C.F.R. §3.73(b).

However, the petition under 37 C.F.R. §1.48(a) cannot be granted until the requirements of 37 C.F.R. §1.47(a) have been satisfied.

As such, the petition under 37 C.F.R. §1.48(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the above-noted deficiencies. Any reply should be entitled "Renewed Petition Under 37 C.F.R. §§1.47(a) and 1.48(a)," and should only address the deficiencies noted above, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a). This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski and may be submitted by mail<sup>6</sup>, hand-delivery<sup>7</sup>, or facsimile<sup>8</sup>.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



**Paul Shanowski**  
**Senior Attorney**  
**Office of Petitions**  
**United States Patent and Trademark Office**

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<sup>4</sup> See MPEP 409.03(d).

<sup>5</sup> The declaration submitted with the present petitions was not executed by joint inventor Mascavage. As such, the petition under 37 C.F.R. §1.47(a) was filed.

<sup>6</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>7</sup> Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

<sup>8</sup> 571-273-8300 - please note this is a central facsimile number.